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Term. Disclaimer

Practitioner's Docket No. Ortho-A-CIP-PCT

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Kay, David B.

Application No.: 10/089,105

Group No.: 3731

Filed: 02/19/1998

Examiner: Julian Woo

For: OPEN HELICAL ORGANIC TISSUE ANCHOR AND METHOD OF FACILITATING HEALING

Assistant Commissioner for Patents  
Washington D.C. 20231

TERMINAL DISCLAIMER TO OBVIATE  
A DOUBLE PATENTING REJECTION (37 C.F.R. Section 1.321(c))

Identification of Person(s) Making This Disclaimer

I, Laura F. Shunk, represents that I am a representative authorized attorney of record to sign on behalf of the inventor. A statement under 37 CFR 3.73(b) is not attached since the application is held by the inventor.

IDENTITY OF THE DISCLAIMANT

The inventor is

David B Kay  
3975 Embassy Parkway  
Akron, OH 44333

RECEIVED

FEB 05 2004

TECHNOLOGY CENTER R3700

CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. SECTION 1.8(a))

I hereby certify that, on the date shown below, this correspondence is being:

MAILING

[ ] deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

FACSIMILE

[ ] transmitted by facsimile to the Patent and Trademark Office, (703) \_\_\_\_-\_\_\_\_.

Date: January 27, 2004

Signature *Laura F. Shunk*

(type or print name of person certifying)

02/03/2004 MBELETE1 00000019 10089105

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(Terminal Disclaimer to Obviate a Double Patenting Rejection--page 1 of 1)

## T.D. INFORMAL MEMO: DO NOT MAIL THIS MEMO TO APPLICANT

DATE: 17-Feb-04APPL. S.N.: 10/089,105TO: EXAMINER Woo, Julian (3731)ART UNIT: 3731FROM: Veney, Sheila

PARALEGAL SPECIALIST

RETURN THIS MEMO TO:

SUBJECT: Decision on Terminal Disclaimer (T.D.) filed: 29-Jan-04

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next Office action to notify applicant of the T.D. If you disagree or have any questions, please see me or the Special Program Examiner. THIS IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE (1) MAILED TO APPLICANT OR (2) PLACED OF RECORD IN THE APPLICATION FILE. When your action is complete, please initial, date and return this memo to me. THANK YOU.

- ☒ The T.D. is PROPER and has been recorded (see ¶ 14.23).
- ☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below (see ¶ 14.24):
- ☐ The TD fee of  has not been submitted nor is there any authorization in the application file for the use of a deposit account (see ¶ 14.26.07).
  - ☐ The T.D. does not satisfy Rule 321 in that the person who has signed the T.D. has not stated the extent of his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent (see ¶¶ 14.26 & 14.26.01).
  - ☐ The T.D. lacks the enforceable only during common ownership clause – needed to overcome a non-statutory double patenting rejection, Rule 321(b) (see ¶ 14.27.01).
  - ☐ The T.D. is directed to a particular claim(s), which is not acceptable since “the disclaimer must be for a terminal portion of the term of the entire patent to be granted” (MPEP 1490) (see ¶¶ 14.26 & 14.26.02).
  - ☐ The person who signed the T.D.:
    - ☐ is not an attorney “of record” (see ¶¶ 14.29 and 14.29.01).
    - ☐ has failed to state his/her capacity to sign for the business entity (see ¶ 14.28).
    - ☐ is not recognized as an officer of the assignee (see ¶¶ 14.29 & possible 14.29.02).
  - ☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame number specified as to where such evidence is recorded in the Office (see 37 CFR 3.73(b) and 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame number may be found in the T.D. or in a separate paper of record in the application (see ¶ 14.30).
  - ☐ The T.D. is not signed (see ¶¶ 14.26 & 14.26.03).
  - ☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting rejection is missing or incorrect (see ¶ 14.32).
  - ☐ The serial number of this application (or the number of the patent in reexam or reissue cases being disclaimed is missing or incorrect (see ¶¶ 14.26, 14.27.02 or 14.26.05).
  - ☐ The period disclaimed is incorrect or not specified (see ¶¶ 14.26, 14.27.02 or 14.26.03).
  - ☐ Other:
  - ☐ Suggestion to request refund (see ¶ 14.36). NOTE: If already authorized, credit refund to deposit account and **do not** check this item.

I have appropriately notified applicant(s) of the status of the Terminal Disclaimer filed in this case.

Ex. Initials: \_\_\_\_\_ Date: \_\_\_\_\_

Log Date: \_\_\_\_\_

### **EXTENT OF DISCLAIMANT'S INTEREST**

The extent of the interest in this invention that the disclaimant owns is in the whole of this invention.

### **RECORDAL OF ASSIGNMENT IN PTO**

No Assignment Required

### **DISCLAIMER**

#### **(Obviousness-Type Double Patenting Rejection Over A Prior Patent)**

Petitioner hereby disclaims, except as provided below, the terminal part of any patent granted on the instant application, which would extend beyond the expiration date of Patent No. 5,662,683 as presently shortened by any terminal disclaimer. Petitioner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the above-listed patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors, or assigns.

In making the above disclaimer, disclaimant does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. Sections 154 to 156 and 173 of the patent forming the basis of the double patenting rejection, namely, Patent No. 5,662,683, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. Section 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to expiration of its full statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

### **DISCLAIMER FEE (37 C.F.R. Section 1.20(d))**

Small entity--fee \$55.00.

Small entity statement already filed in patent application 10/089,105 on February 19, 1998.

**FEE PAYMENT**

Attached is a check in the sum of \$55.00.

Charge Account No. 08-3150 for any fee deficiency.

A duplicate of this disclaimer is attached.

Date: January 27, 2004

Laura F. Shunk

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